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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,340	04/10/2001	Ilya Schiller	11627-004001	9977
26161	7590	05/31/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			LE, BRIAN Q	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/832,340	Applicant(s) SCHILLER ET AL.	
	Examiner Brian Q. Le	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-13 and 38-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/16/2006 has been entered.

Response to Amendment and Arguments

2. Applicant's arguments with regard to claims 1-2, 4-5, and 1-10 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding claim 1, the Applicant argues (pages 6-7) that Rhee U.S. Patent No. 6,137,908 teaches away from the claim invention of receiving "a subset of coordinate points". The Applicant further believes that (top of page 7) that "subset of coordinate points" avoids transmitting or storing the intermediate data points of each stroke so that the file size is kept small to reduce transmission cost. The Examiner respectfully disagrees with this reasoning. First, the claim language does not claim, "a subset of coordinate points avoids transmitting or storing the intermediate data points of each stroke so that the file is kept small to reduce transmission cost" for the Examiner fully consider as explained by the Applicant. If the Applicant would like the Examiner to narrow the interpretation in art rejection entirely as claimed in the specification, the Applicant is advised to consider applying 35 U.S.C. 112, sixth paragraph. Until then, the Examiner will reject the invention **as claimed** (emphasis added). Thus, Rhee teaches a subset of coordinate points (a limited amount of essential x-y data) (column 5, lines 40-50). Also, when considering the amended claim 1, the specification does not provide

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the support the amended language “in which the data comprise no more than a subset of coordinate points representing the handwriting motion”.

Referring to claim 13, the Applicant argues (bottom of page 7) Yamikita Reference does not describe and would not have made obvious storing handwriting information in a server and enable the user to control functions applied to the stored handwriting information after the handwriting information has been stored in the server. The Examiner respectfully disagrees. Yamikita teaches a method of providing an interactive interface for mobile device such as mobile camera or fax to communicate with host device (where data stored) and able to use provided functions to interact with stored handwriting information (page 2, column 1, lines 27-50; page 3, column 3, lines 25-50).

Thus, the rejections of all of the claims are maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10, 12, and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding independent claims 1 and 12, the original specification does not provide the support for the amended limitation “in which the data comprise no more than a subset of coordinate points representing the handwriting motion”. Regarding claim 47, the

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original specification does not disclose, "extracting a phone number form the handwritten information". The Applicant needs to clearly point the exact location (page and line number) for the support of the claimed language.

Claim Objections

5. Claims 42-43 are objected to because of the following informalities: the ending of the two claims by a comma ",". Appropriate correction is required.
6. Claim 45 is objected to because of the following informalities: there is no ending for the claim, "or". Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-5, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and further in view of Rhee U.S. Patent No. 6,137,908.

Regarding claim 1, Yamakita teaches a method comprising:

Receiving handwriting data (writing data on portable terminal) electronically from a remote user at a handwritten-information server (host device) (page 1, column 1), and
Processing the handwriting data in accordance with instructions provided to the server by the user (page 1, column 2). However, Yamakita does not explicitly teach the receiving of

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handwritten-information data by a subset or coordinate points, which represents handwriting motion captured electronically. Rhee further teaches a handwriting recognition method further comprises the method of receiving handwritten-information in a subset of coordinate points format representing handwriting motion captured electronically points (a limited amount of essential x-y data) (column 5, lines 40-50). Modifying Yamakita's method of processing handwriting according to would have been obvious for one skilled in the art to use vector (x, y coordinate) to capture motion of the handwriting and thus record handwriting information. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Rhee.

For claim 2, Yamakita further teaches the method which the handwriting data is generated using a handwriting device at the location of the remote user (portable terminal such as table for special pen/stylus) (page 1, column 1 and FIG. 2).

Regarding claim 4, Yamakita discloses method including performing handwriting recognition at the site of the remote user (page 1, column 2, first 2 lines).

For claim 5, Yamakita teaches the method including performing handwriting recognition at the handwritten-information server (character recognition at personal computer/host device) (column 1, lines 33-38).

For claim 7, Yamakita teaches the method which the handwriting data includes information identifying a destination of the handwriting data (page 2, column 2, lines 30-39).

Referring to claim 8, Yamakita further teaches the method which the processing of the handwriting data includes forwarding it to a destination (page 2, column 2, lines 30-39).

Also to claim 9, Yamakita teaches the method which the forwarding comprises sending the handwriting data in FAX format (page 8, column 13, lines 25-30).

Regarding claim 10, Yamakita teaches the method which the forwarding comprises sending the handwriting data as an email attachment or in a body of an email (content of a email) (column 2, lines 40-50).

9. Claims 3, 6, 12-13 and 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and further in view of Rhee U.S. Patent No. 6,137,908 as applied to claim 3 above, and further in view of Lee U.S. Patent No. 5,347,477.

Regarding claim 3, Yamakita teaches the method which the handwriting data is generated by a special pen (page 2, lines 45-47). Yamakita does not explicitly teach wherein the pen can be electronic wireless pen. Lee further teaches a method processes handwriting wherein handwriting data is generated by an electronic wireless pen (column 3, lines 24-25 and FIG. 5). Modifying Yamakita's method of processing handwriting data according to Lee would able to provide a wireless pen in providing the wireless capability for the apparatus. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Lee.

For claim 6, please refer back to claim 3 for the limitation wherein transmitting the handwritten information wirelessly to a communication device (the concept of wireless pen). In addition, Yamakita teaches the method of including the location of the remote user, forming an electronic file representing the handwritten information (column 1, lines 13-17), and transmitting the electronically captured handwriting from the communication device to the handwritten-information server (page 1, column 1 and column 2).

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For claim 12, please refer back to claims 3 and 6 for the teaching of wireless communication. In addition, Yamakita teaches the concept of storing (computer) (page 2, column 1, line 30).

Referring to claim 13, please refer back to claims 3, 6 and 12 for the teaching of wireless communication. Furthermore, Yamakita teaches a method providing an interactive user interface on a screen of a mobile device to enable a user to control functions (commands) applied (page 7, column 11, lines 39-47) to the stored handwriting information (simple interface) (page 2, column 2, lines 40-45).

Regarding claim 38, Yamakita teaches the method in which providing the interactive user interface includes receiving input through one or more of a screen on the mobile device, a web browser, speech recognition, or touch-tone sequences (a fax has touch-tone sequences) (page 3, column 3, line 41).

For claim 39, Yamakita teaches the method in which receiving input includes receiving additional handwriting information (special pen provides additional handwriting information) (page 2, column 2, lines 45-55)

Referring to claim 40, Yamakita teaches the method in which storing includes converting the handwriting information to a character format (page 2, column 2, lines 35-38).

As to claim 41, Yamakita teaches the method in which the functions include retrieving the handwritten information (page 3, column 3, lines 3-7).

For claim 42, Yamakita teaches the method in which the functions include forwarding the handwritten information to another user (send by email) (page 3, column 3, line 41).

Referring to claim 43, Yamakita teaches the method in which the functions include making the handwritten information available on the Internet (page 4, column 6, lines 25-30).

For claim 44, Yamakita teaches the method in which the functions include perform computations on the handwritten information (handwritten image analysis) (page 8, column 13, lines 45-50).

Regarding claim 45, Yamakita teaches the method in which the functions include interpreting the handwritten information into computer-usable information (converting the handwriting information to a character format to be understood by computer) (page 2, column 2, lines 35-38).

For claim 46, Yamakita teaches the method in which interpreting the handwritten information includes extracting an address from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

Regarding claim 47, Yamakita teaches the method in which interpreting the handwritten information extracting a phone number from the handwritten information (Yamakita provides the ability to extract image data; thus will be able to extract phone number if there is phone number contained in the image data) (column 6, lines 20-23).

For claim 48, Yamakita teaches the method in which interpreting the handwritten information includes extracting a task from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

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Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BL
May 17, 2006